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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,485	05/25/2001	Scott D. Feighner	20251P	8604

210 7590 11/15/2005
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EXAMINER

BASI, NIRMAL SINGH

ART UNIT PAPER NUMBER

1646

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/719,485

Applicant(s)

FEIGHNER ET AL.

Examiner

Nirmal S. Basi

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,4,7,8 and 10-16 is/are pending in the application.
- 4a) Of the above claim(s) 7 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,4,12 and 16 is/are allowed.
- 6) ☐ Claim(s) 8, 10-11, 13-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Amendment filed 8/22/05 has been entered. Applicants arguments filed 12/23/04 have been entered. Claims 1-4, 8, 11-12, 14-16 have been amended, claims 2-3, 5-6, 9 cancelled and claim 7 withdrawn. A complete response to the final rejection must include cancellation of non-elected claims or other appropriate action (37 CFR 1.144) MPEP 821.01.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action (7/18/00).

Claim Rejections - 35 USC § 112

3. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 is indefinite because it is not clear what Applicant is claiming in subsection (a) of claim 8. Subsection (a) states: "transfecting indicator cells with an expression vector set forth in consisting of the nucleotide sequence set forth in SEQ ID NO: 1 or SEQ ID NO: 2". It is not clear where the "expression vector" is "set forth in". It appears a word or phrase is missing after the term "set forth in".
4. The rejection under 35 U.S.C. 102 is recast in view of the amended claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 10, 11, 13, 14 and 15, are rejected under 35 U.S.C. 102(a) as being anticipated by McKee et. al. (See IDS Genomics, Viol. 46, 426-434, 1997, see prior Office Action).

McKee discloses GPR38 receptor polynucleotide/polypeptide (inherently a motilin receptor), which has 100% query match to the coding region of SEQ ID NO: 1 and comprises SEQ ID NO: 2 (encodes the polypeptide comprising SEQ ID NO: 3) of instant application. McKee further discloses vector containing said polynucleotide and cell containing said vector (see Materials and Methods), thereby meeting the limitation of claims 10, 11, 13, 14,15 absent evidence to the contrary. Further the GPR38 is contained in a full-length genomic clone disclosed on page 427, column 1, second paragraph. Although the nucleic acid sequence encoding the GPR38 is not disclosed, the GPR38 clone inherently has the sequence, which encodes the polypeptide comprising SEQ ID NO: 3.

Claim 10 contains the limitation of, "An isolated nucleic acid **comprising** a nucleotide sequence encoding a polypeptide which functions as a human motilin receptor, wherein the nucleic acid sequence is selected from the group consisting of---- a nucleic acid sequence consisting of a nucleotide sequence which encodes a

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polypeptide consisting of the amino acid sequence of SEQ ID NO: 3". McKee discloses the isolation of a nucleic acid which **comprises** a nucleotide sequence which inherently encodes a polypeptide which functions as a human motilin receptor and consists of the amino acid sequence of SEQ ID NO: 3, absent evidence to the contrary. McKee further discloses a vector comprising the nucleic acid of claim 10, absent evidence to the contrary.

Similarly for claim 11 McKee discloses an isolated nucleic acid molecule encoding a protein according to claim 1, wherein the nucleic acid inherently consists of a cDNA sequence identical to one that would be isolated from a human thyroid DNA library, absent evidence to the contrary.

Similarly for claim 14 McKee discloses a vector comprising nucleic acid comprising a nucleotide sequence encoding a polypeptide which functions as a human motilin receptor, wherein the nucleic acid sequence is selected from the group consisting of---- a nucleotide sequence encoding the amino acid sequence of SEQ ID NO: 3, absent evidence to the contrary. Pertaining to claim 15, the cell containing the vector of claim 14 is also disclosed by McKee, absent evidence to the contrary.

"Therefore the disclosure of McKee meets the limitations of claims 10, 11, 13, 14,15, absent evidence to the contrary.

For further clarification it is noted that the rejection of the claims is based on the claims being directed to nucleic acid comprising language. The comprising language reads on species of the polypeptide of SEQ ID NO: 3 (412 amino acids), which comprise the polypeptide (438 amino acids known in the art)

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5. Claims 1, 4, 12 and 16 are allowable.
6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nirmal S. Basi whose telephone number is 571-272-0868. The examiner can normally be reached on 9:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony C. Caputa can be reached on 571-272-0829. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NW
Nirmal Basi
Art Unit 1646
November 10 2005.


JOSEPH MURPHY
PATENT EXAMINER